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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91203884
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Attachments	Registrant's Motion to Dismiss.pdf (21 pages)(106902 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In Re: Application Serial No. 85/324,443
For the Mark: COLOR WARS
Filed: May 18, 2011
Published in the Official Gazette: January 17, 2012

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Ennis, Inc.)	
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Opposer)	
)	
)	Opposition No. 91203884
v.)	
)	
)	
Joel L. Beling d/b/a Supa Characters Pty Ltd)	
)	
Applicant)	
)	

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Joel L. Beling d/b/a Supa Characters Pty Ltd,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92055374
)	
Ennis, Inc.)	
)	Registration No. 3,372,884
)	Mark: COLORWORX
Registrant.)	
)	

REGISTRANT'S MOTION TO DISMISS

Registrant, Ennis, Inc. (“Registrant”), by and through its undersigned counsel and pursuant to Rule 13(a)(1) of the Federal Rules of Civil Procedure, hereby files this Motion to Dismiss Applicant’s Petition to Cancel and would show the Board as follows:

I. PETITIONER FAILED TO PROPERLY FILE THE CANCELLATION

1. A defense attacking validity of a registration is a compulsory counterclaim if grounds for the counterclaim exist when the answer is filed. 37 C.F.R. § 2.114 (b)(2)(i). Specifically, the Trademark Rules state that if grounds for a counterclaim are known to respondent when the answer to the petition is filed, the counterclaim *shall* be pleaded “with or as part of the answer.” *Id.*

2. Petitioner filed its Notice of Opposition against Applicant on or about February 15, 2012 (the “Opposition”). *See* [Doc. #1]. Applicant Joel L. Beling d/b/a Supa Characters Pty Ltd (“Applicant”) filed his Answer to the Opposition on March 4, 2012. *See* [Doc. #4]. Applicant’s Answer to did not attack the validity of Registrant’s registration in and to the mark COLORWORX.

3. Applicant filed his Petition to Cancel Registrant’s mark “COLORWORX” with design element (U.S. Reg. No. 3,372,884) (the “Mark”) with the United States Patent and Trademark Office Trademark Trial and Appeal Board (“TTAB” and “Board”) on or about March 23, 2012 (the “Cancellation”). *See* [Doc. #1 of the Cancellation]. At that point, no discovery had taken place in the Opposition so the grounds upon which Applicant filed his Petition to Cancel were known to Petitioner when he filed his Answer to the Opposition on March 4, 2012. Petitioner’s Petition to Cancel also failed to reference the Opposition. *See* Trademark Trial and Appeal Board Manual of Procedure 313.01. Petitioner’s Second Amended Petition to Cancel

[Doc. #18] must fail as a matter of law because his claim for cancellation was compulsory and should have been brought as a counterclaim in the Opposition. 37 C.F.R. § 2.114 (b)(2)(i).

4. Alternatively, assuming the grounds for his Petition to Cancel were inexplicably discovered only after he filed his Answer in the Opposition, Petitioner's Petition to Cancel failed to reference the Opposition as required by the Rule 313.01 of the Trademark Trial and Appeal Board Manual of Procedure. Further, a Petitioner who fails to timely plead a compulsory counterclaim cannot file a separate Petition to Cancel to avoid the effects of an untimely counterclaim. *Pyttronic Industries Inc. v. Terk Technologies Corp.*, 16 USPQ2d 2055, 2056 n.2 (TTAB 1990).

II. THE CANCELLATION SHOULD BE DISMISSED PURSUANT TO RULE 12(b)(6)

5. In order to withstand a 12(b)(6) Motion to Dismiss for failure to state a claim upon which relief can be granted, Petitioner's complaint must allege such facts as would, if proved, establish that the Petitioner is entitled to the relief sought. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). In other words, the burden rests with Petitioner to establish that (1) he has standing to maintain the proceeding, and (2) a valid ground exists for cancellation of the registration. *Id.*; TTAB Rules 309.03(a)(2). Petitioner's complaint should include enough detail to give Registrant fair notice of the basis for each claim. *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007); TTAB Rules 309.03(a)(2) Elements of a Complaint—In General.

6. A complaint, however, does not suffice if it does nothing more than tender "naked assertions devoid of further factual enhancement. *Ashcroft v. Iqbal*, 556 U.S. 556 (2009). A pleading that merely offers "labels and conclusions" or "a formulaic recitation of the elements of a cause of action will not do." *Twombly*, 550 U.S. at 555. Nor does a complaint suffice if it

tenders “naked assertion[s]” devoid of “further factual enhancement.” *Id.* at 557. Under Federal Rule of Civil Procedure 8(a)(2), a pleading demands more than an unadorned, “the-defendant-unlawfully-harmed-me accusation.” *Id.* at 555.

7. In all respects of his Petition to Cancel, Petitioner has fatally omitted any plausible facts with respect to Registrant’s Mark *in its entirety*, thereby precluding any legally sufficient grounds for cancellation of the COLORWORX registration. Therefore, the Cancellation should be dismissed in its entirety.

A. Petitioner’s Petition to Cancel Should be Dismissed with Regard to Counts I-III Because the Petition Fails to Plead Plausible Facts Attacking Ennis’ Mark as a Whole

8. Despite the Board’s continued directives to Petitioner to amend his Petition to Cancel so as to address the requirements of the Trademark Act § 7, 15 U.S.C. § 1057 and focus on Registrant’s Mark in its entirety, the claims in Petitioner’s Second Amended Petition to Cancel “all suffer from the same deficiency” as its first attempted Petition to Cancel. Petitioner’s claims, again, fail to contain well-plead facts necessary to establish Petitioner’s failed argument that “Ennis’ mark, as a whole, is generic, merely descriptive, and incapable of functioning as a trademark” as applied to Registrant’s goods and services as is required once a mark has attained a valid registration. *See* Trademark Act § 7, 15 U.S.C. § 1057(b); *and* TTAB Consolidated Order, pg. 5, dated July 13, 2012 (hereinafter “Consolidated Order”). Rather than address the Mark in its entirety (the term COLORWORX *and* the design element), Petitioner ignores the Board’s requests and recommendations by electing to focus solely on the term “COLORWORX” alone. Consequently, Petitioner’s claims fail in every respect to meet the pleading requirement addressing the Mark in its entirety. Petitioner’s Mark may not be cancelled on such grounds.

9. Petitions to contest a previously registered mark, like the COLORWORX Mark of Registrant, are subject to the restrictions imposed by 15 U.S.C. § 1057(b) of the Trademark Act. Section 1057(b) plainly provides:

A certificate of registration of a mark upon the principal registered by this chapter shall be *prima facie* evidence of the validity of the registered mark and of the registration of the mark, of the owner's ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.

Trademark Act §7, 15 U.S.C. § 1057(b) (*emphasis added*). Presumptions flowing from the registration are for the mark as a whole and not to its individual parts. *See Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987) (“The registration affords *prima facie* rights in the mark[s] *as a whole*, not in any component. Thus, a showing of descriptiveness or genericness of *part* of a mark does not constitute an attack on the registration.”) (*emphasis added*). Because the USPTO approved the Mark in 2008, its certificate of registration of the mark *as a whole* affords Registrant prima facie evidence of the validity of the registered Mark and of the registration of the Mark, of Registrant's ownership of the Mark, and of Registrant's exclusive right to use of the registered Mark in commerce on or in connection with the goods or services specified in the certificate. 15 U.S.C. § 1057(b).

10. As the Board readily notes, Registrant's registered Mark is not *just* the term COLORWORX; the Mark is comprised of *both* the term COLORWORX *and* a design element. *See Consolidated Order*, pg. 5. Petitioner's claims under Counts 1 through 3, inclusive, fail on the same grounds in that each Count fails to address the COLORWORX term in conjunction with the design element of the Mark. Such claims are unavailable where “it is clear that the mark is composed of a design element and is not generic *as a whole*.” *See Montecash LLC v. Anzar Enters. Inc.*, 95 USPQ 2d 1060, 1062-63 (TTAB 2010) (“A claim that the mark is or has

become ‘... the generic name for the goods or services, or a portion thereof ...’ is a ground unavailable to petitioner in this case. **It is clear that respondent’s mark, composed of a design element *combined* with [the identifying term], is not generic *as a whole*.** [Therefore, **Petitioner’s claim fails where it] *only* asserts that a portion of the mark . . . is a generic term.”) (*emphasis added*). In *Montecash LLC*, the petitioner challenged a validly registered mark of less than five years on the grounds that only a specific portion of the mark containing the term “MONTEPIO” was a generic term. TTAB concluded, however, that the petitioner’s claim that the mark “is or has become ‘. . . the generic name for the goods or services, or a portion thereof . . .’” was unavailable in the case at bar because the petitioner failed to assert that the mark, *in its entirety*, was a generic term. *See id.***

11. Like the petitioner in *Montecash LLC*, the entirety of Petitioner’s claims contained within his Second Amended Petition to Cancel focus solely and erroneously on claims pertaining to the term COLORWORX absent any mentioning of the attached graphic design in conjunction with the term COLORWORX. *See Id.*; and [Doc. #18, ¶¶ 5-13]. Consequently, Petitioner’s claims in Counts 1-3 all fail to state a claim upon which relief can be granted, thereby warranting dismissal of these claims under Fed.R.Civ.P. 12(b)(6). Trademark Act §7, 15 U.S.C. § 1057(b); and *Sweats Fashions Inc.*, 4 USPQ2d 1793, 1797.

12. For example, in Petitioner’s Count I, while the Board could possibly construe some of Petitioner’s factual pleadings with respect to the term COLORWORX as sufficiently plausible, Petitioner fails to demonstrate the same with respect to the design element inclusively. *See* [Doc. #18, ¶¶ 5-8]. Each time Petitioner actually mentions Registrant’s design element, Petitioner simply recites the elements of a cause of action to substantiate his claims. *See Id.* ¶ 10 (“Registrant is not entitled to exclusive use of the term ‘ColorWorx’ and the design element...”),

¶ 12 (“Registrant’s design element is not an original creation and minor variations thereof are used by other traders in the printing industry.”), ¶ 15 (“The general public would not understand or believe that printing services offered in connection with the term ‘ColorWorx’ and the design element refers to Registrant.”), ¶ 16 (“Registrant’s design element, and minor variations thereof, are generic in the printing industry and do not distinguish Registrant’s services from those of other traders.”), ¶ 21 (“If Registrant is allowed to continue to maintain its registration for COLORWORX and the design element, Registrant would be able to continue to improperly obstruct Petitioner’s and other third parties’ generic use of the term ‘color works’ and the design element.”), and ¶ 22 (“Because the term ‘COLORWORX’ and the design element are incapable of serving as an indicator of source as applied to Ennis’ services, Registrant’s U.S. Registration No. 3,372,884 should be cancelled in the absence of a disclaimer of that portion.”). Likewise, Petitioner again repeats this fatal error with his claims in Count II, paragraphs 24, 25, 27-34 and Count III, paragraphs 36, 39, 40, 43. *See Id.* ¶¶ 8-13.

13. Petitioner elects to ignore TTAB’s Order and focuses the entirety of his arguments in Counts I-III on only a portion of Registrant’s Mark. This focus includes completely changing the term “COLORWORX” in Registrant’s Mark into derivatives and renditions of the term in a weak attempt to support his claims. For example, Petitioner states that “[Ennis] is not entitled to exclusive use of the term ‘ColorWorx’ or ‘Color Works’”. *See Id.* ¶ 10. Ennis’ mark is comprised of the term “ColorWorx”—i.e., no spaces between the words “Color” or “Worx” and substitutes an “x” for the “ks” in the word “Works”. Clearly, Registrant’s Mark never intended to use the words “Color” or “Works” separately, nor did Registrant intend to use a correct English spelling of the word “works.” Petitioner’s analysis, again, fails to establish how the term COLORWORX—an intentionally misspelled term formed from two completely

separate words—is generic, merely descriptive, and incapable of functioning as a trademark as applied to Registrant’s goods and services. In fact, Petitioner’s inability to discuss his claims without separating the terms “Color” and “Worx,” by changing the mark’s spelling to “Works,” or simply stating a legal conclusion without support that “ColorWorx” is generic and merely descriptive of products or services dubbed “works of color,” completely contravenes Petitioner’s claims that Registrant’s Mark is generic, merely descriptive, and incapable of functioning as a trademark as applied to Registrant’s goods and services. Petitioner offers no pleaded facts of vendors or intended purchasers *within the United States’ printing service industry* who actually use the term COLORWORX.¹

14. Beyond conclusory statements and a mere recitations of the elements to initiate a Petition to Cancel a validly registered mark in its entirety, not once does Petitioner demonstrate how Registrant’s registered Mark, which comprises the term “COLORWORX” *and* a design element, is generic, merely descriptive, and incapable of functioning as a trademark as applied to Registrant’s goods and services. *See Twombly*, 550 U.S. at 555-57 and [Doc. #18, ¶¶ 5-13]. As a result, the Board must dismiss Petitioner’s claims in Count I, Count II, and Count III of Petitioner’s Second Amended Petition to Cancel.

¹ Notably, Petitioner alleges in a separate section of its complaint, Count 4, the existence of another United States company at the time of Ennis’ original application that offered identical printing services to that of Ennis. What Petitioner fails to realize, and what Ennis requests the Board take judicial notice of, is the fact that the company to which Petitioner refers is a Canadian-based company, offering similar services to that of Ennis in the Canadian market. The web address “www.colorworx.ca” bears the domain name “.ca”, which is given to *Canadian* companies, *not California-based companies*, as Petitioner so alleges in Count 4. While the actual website Petitioner mentions does not specifically state the company’s exact geographical location, a cursory search of the company and its CEO, Shawn Barrett’s, LinkedIn webpage quickly dispels any notion that the Canadian Colorworx competes directly with Ennis’ business in the United States. See <http://ca.linkedin.com/pub/shawn-barrett/51/572/514>.

B. Petitioner's Petition to Cancel Should be Dismissed with Regard to Count IV Because the Petition Fails to State with Particularity Facts and Circumstances Constituting Fraud by Ennis and Ennis' Legal Counsel

15. Petitioner's claims for fraud in Count IV [Doc. #18, ¶¶ 13-87], likewise, fail to state a claim upon which relief may be granted and, therefore, should be dismissed. With respect to Petitioner's allegations of fraud, the Federal Rules of Procedure impose a heightened pleading standard for such allegations. *See* Fed.R.Civ.P. 9(b); *and In re Bose Corp.*, 580 F.3d 1240, 1243 (Fed. Cir. 2009) ("A party seeking cancellation of a trademark registration for fraudulent procurement bears a heavy burden of proof."). Petitioner must state, with particularity, specific facts and circumstances constituting fraud *by clear and convincing evidence* which, if proven, would establish that: (1) there was in fact another use of the same or a confusingly similar mark at the time the oath was signed; (2) the another user had legal rights superior to Ennis'; (3) Ennis knew that the other user had rights in the mark superior to Ennis', and either believed that a likelihood of confusion would result from Ennis' use of its mark or had no reasonable basis for believing otherwise; and that (4) Ennis, in failing to disclose these facts to the U.S. Patent and Trademark Office, Ennis intended to procure a registration to which it was not entitled. *See In re Bose Corp.*, 580 F.3d at 1243; *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 201); Consolidated Order, ¶¶ 6-7; *and* Fed.R.Civ.P. 9(b). **Because intent is a required element to be pleaded for a claim of fraud, allegations that a party made material representations of fact that it "knew or should have known" were false or misleading are insufficient.** *See In re Bose*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009) (reversing and remanding TTAB finding of fraud "[b]ecause there is no substantial evidence that [Registrant] intended to deceive the PTO"). To the extent Petitioner intends to set forth a claim that Registrant and Registrant's legal counsel committed fraud by making false averments in the declaration and oath in support

of its involved application, all such claims are legally insufficient. *See Qualcomm Inc.*, 93 USPQ2d at 1770.

(1) Petitioner’s Allegations of Fraud in Sections IV(A)1-24 Should be Dismissed for Failure to Proffer Evidence of Fraudulent Conduct Pertaining to Ennis’ Procurement of its Registration of the Mark as a Whole

16. As mentioned, *supra*, 15 U.S.C. § 1057(b) precludes apportioned allegations of fraud in registering Registrant’s Mark, i.e., “*Alleged Fraud with respect to [Ennis’] design element*” [Doc. #18, Section IV(A)1-5, ¶¶ 80-114] and “*Alleged Fraud with respect to the word COLORWORX*” [Doc. #18, Section IV(A)6-24, ¶¶ 115-212]. Because the USPTO approved Registrant’s application of the Mark in 2008, its certificate of registration of the mark affords Ennis *prima facie* evidence of the validity of the registered mark and of the registration of the mark, of Ennis’ ownership of the mark, and of Ennis’ exclusive right to use of the registered mark in commerce on or in connection with the goods or services specified in the certificate, with respect to the *entire mark* (i.e., the term COLORWORX *and* the design element). *See* 15 U.S.C. § 1057(b). Petitioner’s claims in Sections IV(A)1-24 [Doc. #18] all possess the same fatal flaw as Petitioner’s aforementioned allegations, in that Petitioner fails to discuss its allegations of fraud with respect to Registrant’s Mark *as a whole*. *See Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987); *see also* 15 U.S.C. § 1064(3) (cause of action only available if the registration of the entire registered mark “was obtained fraudulently”).

17. Registrant’s Mark, again, is comprised of both the term COLORWORX *and* the design element. Neither the term COLORWORX nor the design element operate independently of the other in Registrant’s Mark. For Petitioner to suggest to the Board that one operates

independently of the other, or that one element was procured independently of the other, completely ignores Registrant's valid registration of the Mark as a whole.

18. Not once has Registrant represented to Petitioner or the USPTO that it desires to register, or has registered, marks specifically and individually for the red and gray cross-hair design element without the word COLORWORX as a whole. Petitioner's allegations in Sections IV(A)1-5 [Doc. #18] appear to be the result of an Internet search for any and all cross-hair-like designs, to which Petitioner then attempts to proffer to the Board vague similarities of each design. For example, Petitioner's first example of Registrant's alleged fraudulent procurement of the cross-hair design element likens Registrant's design element to that of Xerox. Registrant's design element looks like this:



Xerox's design looks like this²:



While both designs may possess similarities in that they contain circular objects with an X-shaped overlay, Ennis' and Xerox's marks both contain completely different written terms paired with the design element (e.g., Xerox's mark has the term "XEROX" in the mark and Ennis' mark contains the term "COLORWORX" in the mark). Petitioner repeats this flawed analysis throughout the entirety of paragraphs 80-114. [Doc. #18, ¶¶ 80-114].

19. Likewise, Registrant has never represented to Petitioner or the USPTO that it desires to register, or has registered, marks specifically and individually for the terms "Color",

² <http://www.xerox.com/>

“Works”, “Color Works”, “Works of Color”, “Colorworks”, or any other variation of the term beyond that for which Registrant possesses a valid registration, i.e., COLORWORX. Petitioner’s analysis is replete with references to other United States and foreign companies merely using a phonetic variation of the term “Color Works”, yet fails to proffer factual statements regarding any United States companies using the neologism COLORWORX, as one single word with no spaces and the letter “x” substituted for the “ks” at the end of the term.

20. In paragraph 122, [Doc. #18, ¶ 122], Petitioner refers to a United States company, Creative Hairdresser’s, Inc., which allegedly applied for registration of the term “Colorworx” in 1998. *Id.* ¶ 122. Not only does Petitioner readily admit in its Petition that such application pertained to different goods and services, *see Id.* ¶ 122, n.2, but a simple search on the USPTO website’s Trademark Electronic Search System (“TESS”) reveals that this mark was abandoned on June 29, 2000, and has not been renewed since that date. *See* <http://tess2.uspto.gov/bin/showfield?f=doc&state=4006:3e1157.2.1>. General trademarking principals maintain that once a mark has been abandoned, the mark returns to the public domain and may be appropriated for use by other actors in the marketplace in accordance with basic rules of trademark priority. *See* 15 U.S.C. § 1115(b)(2); *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 147 (2d Cir. 2007). Once Creative Hairdresser’s, Inc. abandoned its mark in the year 2000, nearly eight (8) years before the USPTO issued a registration for the Mark, Registrant and all other persons and entities seeking to use such word mark were free to use the term “Colorworx” in commerce on or in connection with their goods or services.

21. Consequently, because Petitioner fails to allege particular facts in Count IV, Sections IV(A)1-24 [Doc. #18, ¶¶ 80-212], with respect to Registrant’s Mark as a whole, Petitioner’s claims in these sections should be dismissed in their entirety.

(2) Petitioner's Allegations of Fraud in Sections IV(A)25-30 Fail to Plead Allegations that Ennis "Knew or Should Have Known" of Phonetically Similar Marks or Confusingly Similar Marks in the U.S.

22. Notwithstanding Petitioner's inability to discuss Registrant's Mark in its entirety for the first 45 pages of his Petition to Cancel, Petitioner's allegations in Sections IV(A)25-30 [Doc. #18] all fail to rise beyond a level demonstrating that Registrant in some manner "knew or should have known" of phonetically similar, unregistered marks when procuring its own registration.

23. In Section IV(a)25, Petitioner erroneously refers to an alleged "Californian" printing company likewise bearing the name "ColorWorx" as proof that such company possessed rights superior to Registrant for the mark "ColorWorx" at the time of Registrant's application. *See* [Doc. #18, ¶¶ 213-17]. Despite Petitioner's continued repetition of its fatal mistakes to only mention the use of the term "ColorWorx" in these paragraphs (*see, supra*, Sections I, II(A)), Petitioner inaccurately characterizes this company as a United States business by calling it a "Californian print company" without offering any proof that this company has or is currently doing business in the United States or even has offices in the United States. *See Id.* ¶ 215. Registrant assumes Petitioner bases this allegation upon its erroneous interpretation that the web address "www.colorworx.ca" and the domain name ".ca" in some way demonstrates that the company is California-based. *See Id.* ¶ 214. However, the domain name ".ca" is given to Canadian-based businesses. *See* "ccTLDs", "C", <http://support.godaddy.com/help/article/4511/glossary-of-tlds>. Additionally, Petitioner fails to proffer any evidence that this Canadian-based company currently possesses or has ever possessed a registered *United States* mark with the term "ColorWorx" and the included design

element. Thus, the reference is irrelevant to the causes of action Petitioner has presented to TTAB.

24. In Sections IV(A)26-30, paragraphs 218-33 [Doc. #18], Petitioner erroneously attacks Registrant's previous legal counsel, Mr. Conrad C. Pitts and Mr. Sean L. Collins, and Registrant, itself, on the basis that each signed the declaration or oath attached to Registrant's application for the Mark despite the false allegation that each knew or should have known: (1) of another entity's use of the same or a confusingly similar portion of the mark, (2) of another entity's legal rights superior to Registrant's rights, (3) that each believed that a likelihood of confusion would result from Registrant's use of the Mark or had no reasonable basis for believing otherwise, and (4) that each failed to disclose these facts to the USPTO during the process of procuring Registrant's Mark. *See* [Doc. #18, Sections IV(A)26-30, ¶¶ 218-33]. Petitioner, however, fails to mention any particular facts, beyond mere conclusory allegations, demonstrating any actual or constructive knowledge held by Mr. Pitts, Mr. Collins, or Registrant of another entity's use and rights to such marks, along with particular facts demonstrating an intent by Mr. Pitts, Mr. Collins, or Registrant's to fraudulently procure Registrant's Mark. *See In re Bose*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009) (allegations that a party made material representations of fact that it "knew or should have known" were false or misleading are legally insufficient for claims brought under 15 U.S.C. § 1064(3)).

25. Consequently, because Petitioner fails to allege particular facts in Count IV, Sections IV(A)25-30, with respect to Registrant and Registrant's legal counsel demonstrating an intent to commit fraud in procuring its application and maintaining its registration, Petitioner's claims in these sections should be dismissed in their entirety. *See* [Doc. #18, ¶¶ 213-33].

(3) Petitioner’s Allegations of Fraud in Sections IV(B)1-23 Fail to Proffer Evidence of Fraudulent Conduct Pertaining to Ennis’ Procurement of its Registration of the Mark as a Whole and Fail to Plead Allegations that Ennis “Knew or Should Have Known” of Phonetically Similar Marks or Confusingly Similar Marks in the U.S.

26. In order to spare the Board an unnecessary repetition of Registrant’s reasons for dismissal, Registrant incorporates the aforementioned reasons for dismissal of the claims contained within Sections IV(B)1-23, paragraphs 234-370, [Doc. #18]. Each of Petitioner’s claims, with respect to Registrant and Registrant’s current legal counsel, including Mr. Edwin Flores, Mr. Scott Meyer, and Mr. Tom Jacks, fails to plead particularized facts demonstrating any intent to fraudulently procure and/or maintain Registrant’s registration of its Mark. *See In re Bose*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009) (allegations that a party made material representations of fact that it “knew or should have known” were false or misleading are legally insufficient for claims brought under 15 U.S.C. § 1064(3)). Likewise, Petitioner’s claims in Sections IV(B)1-5 [Doc. #18] all possess the same fatal flaw as Petitioner’s aforementioned allegations, in that Petitioner fails to discuss its allegations of fraud with respect to Registrant’s Mark *as a whole*. *See Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987); *see also* 15 U.S.C. § 1064(3) (cause of action only available if the registration of the entire registered mark “was obtained fraudulently”). Petitioner’s claims in Sections IV(B)6-23 appear to demonstrate nothing more than Petitioner’s dissatisfaction with the TTAB litigation discovery process, continued erroneous references to the Canadian-based company using the term “ColorWorx”, references to other phonetic variations of the phrase “Color Works”, belittlement of Registrant’s and Registrant’s counsel for its alleged inability to conduct “simple” Google searches with “the competence of an eight-year-old child,” unfounded

factual assertions accompanied by mere conclusory allegations, and multiple spelling errors. *See* [Doc. #18, Sections IV(B)6-23, ¶¶ 258-370].

27. Consequently, because Petitioner fails to allege particular facts in Count IV, Sections IV(B)1-23, with respect to Registrant's Mark as a whole or particularized facts demonstrating an intent by Registrant and Registrant's legal counsel to commit fraud in procuring its application and maintaining its registration, Petitioner's claims in these sections should be dismissed in their entirety. *See* [Doc. #18, ¶¶ 234-370].

C. Petitioner's Petition to Cancel Should be Dismissed Because his 89 Page Petition Violates FRCP 8(a)(2) and (d)(1)

26. Despite the Board's repeated advice to Petitioner to seek local counsel more familiar with the United States trademark litigation and TTAB rules and regulations, Petitioner's continued insistence on representing this matter *pro se* has left not only this Court, but Registrant and Registrant's legal counsel, as well, with an 89 page pleading violative of Federal Rule of Civil Procedure 8(a)(2) and (d)(1). Rule 8 expressly states, in relevant part:

- (a) Claim for Relief. A pleading that states a claim for relief must contain:
 - (2) a *short and plain statement of the claim* showing that the pleader is entitled to relief . . .
- (d) Pleading to Be Concise and Direct; Alternative Statements; Inconsistency.
 - (1) In General. Each allegation must be *simple, concise, and direct*.

Fed.R.Civ.P. 8(a)(2) and (d)(1) (*emphasis added*); *see also Ashcroft v. Iqbal*, 556 U.S. 662 (2009) (petitioner must include the elements of each claim in a *simple, concise, and direct manner*, and must state claims to relief that are facially "plausible"). When a complaint fails to comply with the requirements of FRCP 8, the court has the power, on motion or *sua sponte*, to dismiss the complaint or to strike such parts as are redundant or immaterial. *See Simmons v. Abruzzo*, 49 F.3d 83, 86-87 (2d Cir. 1995).

27. Petitioner's 89 page Second Amended Petition to Cancel is unquestionably comprised, in large majority, of bare-bone legal conclusions, incoherent and sporadic thoughts, and unfounded factual assertions. For example, drawing TTAB's attention specifically to "Count I," paragraphs 9-22 [Doc. #18], this entire section is completely devoid of any factual statements to support Petitioner's claims for "genericness." Instead, Petitioner alleges its own opinions (e.g., in [Doc. #18, ¶ 11], "The term 'color works' obviously refers to works of color"), or Petitioner refers without specificity to the alleged findings of his own "discovery" procedures. *See* [Doc. #18, ¶ 14]. Nothing about Petitioner's allegations could be construed to rise above the level of mere speculation, let alone meet the plausibility standard imposed by the Supreme Court in *Twombly* and *Iqbal*.

28. Likewise, the majority of Petitioner's "claims" appear to be either excessively redundant or just completely immaterial to the claims copied and pasted from another section within his complaint. Drawing the Board's attention to Petitioner's Count IV(A)1-30, Petitioner's claims are nothing more than 34 pages of repeated copying and pasting of various companies that Petitioner alleges in some form or fashion share small characteristics in common with *portions* of Registrant's Mark. Petitioner carries on this same process of pleading its allegations throughout the entirety of its 89 page Petition, which causes great confusion to anyone trying to ascertain Petitioner's claims, much let provide proper notice to Registrant of the claims brought against it in the Petition.

29. While Registrant and its legal counsel understand that Petitioner's lack of organization, research, and familiarity with the United States trademark litigation process combined with his continued refusal to heed the Board's instructions and Petitioner's repeated unprofessional conduct directed at Registrant's prior and current counsel, alone, do not provide

the basis for granting a Motion to Dismiss, the claims contained in Petitioner's Second Amended Petition to Cancel in no way conform to the "short and plain statement of the claim" requirement of FRCP 8(a)(2), nor the "simple, concise, and direct" allegation requirement of (d)(1). As such, Petitioner's Petition to Cancel should be dismissed in its entirety.

D. Petitioner's Petition to Cancel Should be Dismissed with Regard to Count I Because the Petition Fails to Plead Plausible Facts Supporting the Claim that the Mark is Generic

30. With respect to Petitioner's claims in Count I, paragraphs 9-22, [Doc. #18], Petitioner fails to allege facts plausibly demonstrating how Registrant's Mark, as a whole, is merely generic and warrants cancellation under 15 U.S.C. § 1064(3). Registrant readily concedes that a petition to cancel may be filed against a registered trademark holder "at any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered..." 15 U.S.C. § 1064(3). No part of Petitioner's claims in Count I, however, sufficiently demonstrate, much less allege, how Registrant's Mark as a whole is generic.

31. The test for genericness focuses upon the "primary significance of the mark to the relevant public." *Colt Defense LLC v. Bushmaster Firearms, Inc.*, 486 F.3d 701, 709 (1st Cir. 2007). To satisfy this requirement, Petitioner must plead facts to demonstrate that not only does a mark no longer only and exclusively indicate the producer (the "source"), but, more importantly, that such mark now serves a dual function—that of identifying a product while at the same time indicating its source. *See Genesee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137, 144 (2d Cir. 1997). But a mark is not generic merely because it has *some* significance to the public as an indication of the nature or class of an article. *Id.* Rather, in order to become generic, the *principal* significance of the work must be its indication of the nature or class of an article,

rather than an indication of its origin. *Id.* Only when the relevant public—i.e., the actual or potential purchasers of the particular goods or services in the marketplace—ceases to identify a trademark with a particular source of a product or service and, instead, identifies the mark with a class of products or services regardless of source, does that mark become generic and is lost as an enforceable trademark. *Id.*

32. Examples of generic marks that have or would possibly satisfy the test under 15 U.S.C. § 1064(3) would be: (1) “Aspirin,” originally a trademark of Bayer AG; or (2) “Yo-yo,” originally a trademark of Duncan Yo-Yo Company; or (3) “Zipper,” originally a trademark of B.F. Goodrich. The relevant public who would purchase aspirin (e.g., individuals suffering from pain and inflammation) identifies an aspirin as a small, over-the-counter pill used to decrease the effects of pain and inflammation—not the once-registered trademark of Bayer AG. The relevant public who would purchase yo-yo’s (e.g., children) identifies a yo-yo as a small, plastic toy with an axle connected to two disks that spins from a string when dropped from the palm of one’s hand—not the once-registered mark of Duncan Yo-Yo Company. The relevant public who would purchase zippers (e.g., individuals purchasing items of clothing) identifies a zipper as the commonly used, tooth-like fastener used for temporarily joining the edges of fabric—not the once registered mark of B.F. Goodrich.

33. Petitioner, on the other hand, fails to allege any facts supporting a claim for genericness to warrant a dismissal under 15 U.S.C. § 1064(3). Instead, Petitioner alleges the results of his own searches “on the google.com search engine” using the word “Color Works”—a completely distinguishable variation of Registrant’s phrase COLORWORX to proffer evidence of genericness. The fact that Petitioner fails to even insert the exact phrasing used in

Registrant's Mark demonstrates Petitioner's failure to demonstrate, let alone allege, evidence of genericness.

34. Likewise, Petitioner's claims fail under the test from *Genesee Brewing Co.* to allege the proper relevant public to whom the Mark has become generic. Instead, Petitioner mistakenly, and fatally to his own claims, proffers a blanket conclusion derived from his own suppositions that the "general public would not understand or believe that printing services offered in connection with the term 'ColorWorx,' and the design element refers to Registrant." *See* [Doc. #18, ¶ 15]. Overlooking the obvious fact that these allegations lend absolutely no support to a claim for genericness but, rather, fall under claims for indistinguishability, Petitioner fails to correctly allege the proper relevant public who might believe Registrant's Mark to be generic in the intended market.

35. Finally, Petitioner continually attempts to confuse the Board with completely distinguishable variations of the phrase used in Registrant's Mark. Registrant's Mark contains the phrase COLORWORX—not "Color Works" [Doc. #18, ¶¶ 10, 11, 14, 17, 18, 19, and 20], or separate words "color" and "works" [Doc. #18, ¶¶ 11, 12, 13, 17, 18, 19, and 20]. Following Petitioner's argument, one could presume that the mark of the legal database WESTLAW® should be cancelled because the words "west" and "law" are individually generic terms. The fact that Petitioner attempts to hide the ball from the Board by including, in its allegations, completely distinct variations of the phrase portion of Registrant's Mark without mentioning the correct spelling and construction of that phrase demonstrates Petitioner's inability to support a claim for genericness. Consequently, Petitioner's claims under Count I, paragraphs 9-22 [Doc. #18], should be dismissed.

36.

PRAYER

WHEREFORE, PREMISES CONSIDERED, Registrant prays that Petitioner's Second Amended Petition to Cancel be dismissed with prejudice and that Registrant be awarded all other relief to which it is entitled, both at law and in equity.

Dated: August 27, 2012

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing REGISTRANT'S MOTION TO DISMISS was served on all counsel of record, this the 27th of August, 2012, by sending the same via electronically through the Electronic System for Trademark Trials and Appeal ("ESTTA") and electronic mail service.

/s/Scott A. Meyer
Scott A. Meyer